

REMARKS

This is in response to the Examiner's Office Action mailed January 17, 2006. For the sake of clarity, the Applicant will respond to each of the paragraphs contained in the Examiner's Office Action in like numerical order.

1. Acknowledged.

2. The Applicant acknowledges that Claims 5, 9, 11, and 24-25 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected species.

3. Acknowledged. Claim 1 has been Amended in order to correct the informalities that have been identified by the Examiner.

4. Acknowledged.

5. The Examiner has rejected Claims 19-20 under 35 U.S.C. 102 (b) as being anticipated by Oh (U.S. Patent 6,422,578 B1).

It is believed that present claims 19 and 20 are entitled to a priority date before the effective priority date of Oh. The present Patent Application Serial Number 10/628,540 is a Continuation-In-Part of Patent Application Serial Number 09/228,206 that was filed on January 11, 1999, and Figures 1-24 of this application and the description of the drawings were present in the parent Patent Application. Claims 19 and 20 are supported by those figures and thus have priority to January 1, 1999. U.S. Patent 6,422,578 B1 granted to Oh on July 23, 2002 was filed about ten months later on November 1, 1999. Accordingly, because the present Patent Application 10/628,540 has claimed priority to the earlier filing date of Serial Number 09/228,206, and claims 19 and 20 are supported therein, the Oh reference does not constitute prior art regarding the structure being claimed by the Applicant in claims 19 and 20. Further, as will be discussed in greater detail below in paragraph 9, Oh does not teach a rotatable brake pad positioned at approximately the middle of a skate chassis on the medial side.

The Examiner of the parent Patent Application Serial Number 09/228,206 had allowed claims 25-28 in that application in his Office Action mailed March 26, 2003. Claim 19 in the present Patent Application 10/628,540 is identical to the allowed old Claim 26 except for the second use of the word "having" has been changed to comprising. Present dependent claim 20

contains matter previously allowed in old Claim 25, and has also been made dependent on present Claim 19. Present Claim 21 is also dependent on present Claim 19. Accordingly, it is believed that new Claims 19-21 define patentable matter and are in condition for allowance with removal of Oh as a reference.

6. Acknowledged.

7. The Examiner has rejected Claims 1-3, and 6 under 35 U.S.C. 103(a) as being unpatentable over Chi (U.S. Patent 6,729,629 B2) in view of Bryce (U.S. Patent 6,331,007 B1).

The present Patent Application Serial Number 10/628,540 is a Continuation-In-Part of Patent Application Serial Number 09/228,206 that was filed on January 11, 1999, and Figures 1-24 were present in the parent Patent Application (see paragraph 5 above). U.S. Patent 6,729,629 B2 granted to Chi on May 4, 2004 was filed on April 30, 2002, and published on October 30, 2003. Accordingly, because the present Patent Application 10/628,540 has priority to an earlier filing date of Serial Number 09/228,206, the Chi reference does not constitute prior art regarding the structure being Claimed by the Applicant in claims 1-3 and 6.

Further, as the Examiner states in the Office Action, at page 4, line 10: "Chi does not expressly state that the cleat locking mechanism can be secured in functional relation to a bicycle pedal." This is correct. Chi does not teach or suggest the use of his mechanism as a means for removably securing an article of footwear in functional relation to a bicycle pedal. The structure taught by Chi is not a bicycle cleat system and does not suggest such use, because the Chi device is not usable for bicycle pedal cleats. In brief, the structure taught by Chi is believed to be inoperable for use with a bicycle cleat and pedal.

In addition, the Examiner cites Bryce's U.S. 6,331,007 B1, and in particular, the following passage therein: "it is to be understood that the invention [a locking mechanism assembly] could have application with other items of sports equipment such as bicycles." However, Bryce's binding apparatus is completely unsuitable for use with a bicycle cleat and pedal system because as recited in the last sentence of his abstract: "The release of the first part from the second part is allowed exclusively upon application of an upwardly directed breakaway force." This teaching of Bryce is not functional regarding a bicycle cleat and pedal system. Cyclists do not want and can ill afford to have a bicycle cleat and pedal system disengage merely upon application of upwardly directed force. In sum, the Bryce teaching would be functionally inoperable for use as a bicycle cleat and pedal system, and the inoperability for a bicycle cleat

and pedal system would be recognized by persons of ordinary skill in the art. Such person of ordinary skill thus would reject the Bryce teaching for use in the structure of present claims 1-3 and 6. Thus, Bryce does not render claims 1-3 and 6 obvious.

8. The Examiner has rejected Claims 4 and 18 under 35 U.S.C. 103(a) as being unpatentable over Chi (U.S. 6,729,629 B2) and Bryce (U.S. Patent 6,331,007 B1) as applied to Claim 1, and further in view of Ricci (U.S. Patent 6,497,420 B2).

The Applicant's remarks concerning the Chi and Bryce reference have been provided above. However, the Applicant acknowledges that in-line skates, and also wheeled skates having means for adjusting the longitudinal length of a wheeled skate are known in the prior art relating to skates. Claims 4 and 18 are believed allowable in combination with parent claim 1.

9. The Examiner has rejected Claim 21 under 35 U.S.C. 103(a) as being unpatentable over Oh (U.S. 6,422,578 B1).

The Applicant's remarks concerning the Oh reference have been provided above, and for the reasons previously discussed it does not constitute a prior art reference. Claim 21 is supported in the Applicant's parent application filed on January 11, 1999, well before the filing of the Oh reference.

10. The Examiner has rejected Claim 16 under 35 U.S.C. 103(a) as being unpatentable over Chi (U.S. 6,79,629 B2) and Bryce (U.S. 6,331,007 B1) as applied to claim 1, and further in view of Stephenson.

The Applicant acknowledges that front and rear removable brake pads as shown in Stephenson are taught in the prior art, but claim 16 is believed allowable in combination with parent claim 1.

11. Acknowledged.

12. Acknowledged.

13. Acknowledged.

In conclusion, the Applicant believes that Claims 1-4, 6-8, 10, 12-16, 18-23, as amended, and new Claims 26-33 of the present Patent Application Serial Number 10/628,540 define

patentable matter and are in condition for allowance.

Favorable action is respectfully requested. The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Nickolas E. Westman, Reg. No. 20,147

Suite 1400 - International Centre

900 Second Avenue South

Minneapolis, Minnesota 55402-3319

Phone: (612) 334-3222 Fax: (612) 334-3312

NEW/rkp